

REMARKS

Applicants have now had an opportunity to carefully consider the Examiner's comments set forth in the Office Action of March 18, 2010. Claims 1-34 remain in this application. Claims 1-19 are allowed. Claims 20 and 21 have been amended. Applicant submits that the proposed amendments herein do not require any additional search on the part of the Examiner, and therefore should be entered after final.

Reconsideration of the Application is requested in view of the comments and amendments herein.

The Office Action

Claim 20 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Webster (U.S. 5,617,215) in view of Allen (U.S. 6,549,299).

Claims 21-24, 33, and 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Webster in further view of DeHority (U.S. 5,129,639) and Allen.

Claims 25, 26, and 32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Webster, DeHority, and Allen as applied to claim 21, and further in view of Hower (U.S. 5,467,434).

Claims 27-31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Webster, DeHority, Allen, and Hower as applied to claim 26, and further in view of Nielsen (U.S. 6,639,687).

The Subject Claims Patentably Distinguish Over the References of Record

Independent claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Webster (U.S. 5,617,215) in view of Allen (U.S. 6,549,299). Applicants respectfully traverse.

As amended, independent claim 20 recites a digital system for integrating and controlling assembler/finishing processes. The digital system includes a production monitor controller capable of separating a production job into job segments based upon the capabilities and constraints of devices to be used in the production process, at least one database for storing information concerning the capabilities and constraints of devices to be used in the production process and for storing job segment descriptions, and a finishing module coordinator, in communication with assembler/finisher devices and with at least one database, for control, tracking, and integrity functions of job segments during the production process. The production

monitor controller is capable of outputting a complete set of printing and assembling/finishing instructions for each job segment. The assembler/finisher devices are programmed to automatically process an assembly and finishing operation based upon instructions created prior to producing a job segment. Applicants respectfully submit that Webster and Allen do not, individually or in combination, teach or suggest the subject limitations as presently claimed.

The Examiner maintains the position that although Webster fails to teach a finishing module coordinator separate from a production module controller as claimed, Allen discloses a separate finishing module coordinator that provides instructions that indicate various things about the tasks that are to be performed by the finishing machines and it would have been obvious to one of ordinary skill in the art to use a separate finishing coordinator to allow for the use of less expensive machines. In response to Applicant's argument that the proposed modification of Webster in view of Allen is improper, since Webster teaches away from having a finishing module coordinator separate from a production module controller, the Examiner submits that Webster does not disparage using a separate finishing module coordinator, thereby does not teach away from doing so. Specifically, the Examiner reasons that a reference does not teach away if "it merely expresses a general preference for an alternative invention but does not criticize, discredit, or otherwise discourage investigation into the invention claimed." Applicant, however, submits that Webster does not merely express a general preference for an alternative invention, but Webster is specifically directed to creating modules that are capable of standalone operation and are not control dependent on neighboring modules. (See col. 5, lines 42-44).

Webster describes that a machine module is standalone (col. 5, lines 50-51), and explicitly states that "[t]here is one and only one Mark Facility Controller per configuration of machine modules..." (col. 8, lines 34-36). Accordingly, although Webster does not explicitly disparage implementing a separate finishing coordinator, Webster specifically teaches that a single module is superior over integrated machines comprised of modules that are functionally interdependent. (See col. 1, lines 37-39). "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. The degree of teaching away will of course depend on the particular facts; in general, a reference will teach away if it suggests that the line of development flowing from the reference's

disclosure is unlikely to be productive of the result sought by the applicant. *See United States v. Adams*, 383 U.S. 39, 52, 148 USPQ 479, 484 (1966).

Moreover, claim 20 has been amended to specify that the printer monitor controller is capable of outputting a complete set of printing and assembling/finishing instructions for each job segment. Applicant submits that the amendment to claim 20 does not present any new limitations that would require an additional search, since as seen on page 20, line 23-page 21, line 7, the amendment to claim 20 is simply a more generalized description of the specific limitations provided in claim 1. Accordingly, the limitation has already been searched by the Examiner and the amendment should be entered after final.

The scheduler in Webster simply takes in jobs, represents the jobs as an assembly tree, and maps the jobs onto various machine modules. An assembly tree represents a document or job requirement and is used to specify a document to be printed. Webster specifically recites that the assembly tree simply describes a physical document rather than prescribing various actions to be taken. (col. 13, lines 7-9). Accordingly, the scheduler in Webster is not capable of outputting a complete set of printing and assembly/finishing instructions for each job segment as is presently claimed.

For at least the aforementioned reasons, Applicant submits that independent claim 20 patentably distinguishes over Webster in view of Allen. Accordingly, the rejection should be withdrawn.

Claims 21-24, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Webster in view of DeHority, and Allen. Additionally, claims 25, 26, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Webster, DeHority, and Allen, as applied to claim 21, and further in view of Hower; and claims 27-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Webster, DeHority, and Allen, as applied to claim 26, and further in view of Nielsen. Applicants respectfully traverse for at least the following reason. The cited references do not, individually or in combination, teach or suggest the presently claimed limitations.

Independent claim 21 has been amended to specify that the production monitor controller outputs job coordination and optimization information, database representation of the structure of job segments, PDL file for job tracking sheet, PDL for a fetch sheet, integrity descriptors, virtual job tickets for the production and finishing devices, and a prompt to call one or more human operators, being based at least in part upon the constraints of the finishing device. According to

the Examiner's comments regarding the reason for allowance of claims 1-19, the cited prior art does not disclose a production monitor controller that outputs the presently claimed information. (Page 15 of the Current Office Action). Accordingly, Applicant submits that independent claim 21, along with claims 22-34 that depend therefrom, patentably distinguishes over the references of record and the claims should thereby be allowed.

CONCLUSION

For the reasons detailed above, it is submitted all remaining claims (Claims 1-34) are now in condition for allowance. The foregoing comments do not require unnecessary additional search or examination.

☒ Remaining Claims, as delineated below:

(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT LESS HIGHEST NUMBER PREVIOUSLY PAID FOR		(3) NUMBER EXTRA
TOTAL CLAIMS	34	- 34 =	0
INDEPENDENT CLAIMS	3	- 3 =	0

☒ This is an authorization under 37 CFR 1.136(a)(3) to treat any concurrent or future reply, requiring a petition for extension of time, as incorporating a petition for the appropriate extension of time.

☒ The Commissioner is hereby authorized to charge any filing or prosecution fees which may be required, under 37 CFR 1.16, 1.17, and 1.21 (but not 1.18), or to credit any overpayment, to Deposit Account 24-0037.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby authorized to call 216-363-9000, at Telephone Number (216) 363-9000.

Respectfully submitted,

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Date

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